

REMARKS

Claim Rejections under 35 USC §102

Claim 1 is rejected under 35 USC §102(e) as being anticipated by Tajima (U.S. Patent No. 6,455,325).

In Tajima, as clearly explained in column 7 between lines 19-27, “In the present invention, in a case where a liquid is sucked or discharged with a so-called single nozzle, the liquid is sucked by contacting a tip section for a chip set in the liquid sucking/discharging line to an internal bottom of a vessel with the liquid accommodated therein and then lightly raising the tip section, so that almost all of the liquid within the vessel can be sucked and uniformity of reaction can be maintained.”

Therefore, in Tajima, the contacting tip section is not in contact with the vessel while suction is being performed.

In contradistinction, as clearly shown by way of an example in Figures 5B-5C of the present invention, the distal end 2A of the suction nozzle 2 is in contact with the inner wall surface 6b of the vessel while suction is being performed. Furthermore, the distal end 2A is located at a lowest position of the inner wall surface 6b of the vessel.

To ensure these differentiations are accurately reflected in independent claim 1, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof in contact with a lowest position of the inner wall surface of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.”

These features are not disclosed in the asserted prior art. It is well settled that:

“A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988).”

Should the Office continue to believe that the claimed invention is anticipated by the asserted prior art, a citation of where each and every claimed feature, either as column number and line number, or figure number and reference numeral, or a combination thereof, as disclosed in the asserted prior art is respectfully requested. Should the Office determine that any claimed feature is not disclosed in the asserted prior art, it is respectfully submitted that the claimed invention is not anticipated by the asserted prior art. Allowance of the claimed invention is then respectfully requested.

Claim 1 is rejected under 35 USC §102(e) as being anticipated by Tyberg et al. (U.S. Patent No. 6,270,726).

As clearly seen in Figures 3A-3C of Tyberg, the pipetting tip 36 can never reach a lowest position of the inner wall surface of a vessel, because the diameter of the pipetting probe too wide relative to the diameter of the vessel.

In contradistinction, as clearly seen by way of an example in Figures 5B-5C, the diameter of the suction nozzle 2 is proportionally many times small than the widest portion of the diameter of the vessel 6a. This would permit the distal end 2A to be in contact with the lowest position of the inner wall surface 6b of a vessel 6.

Again, to ensure this distinction is accurately reflected in the claim, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof in contact with a lowest position of the inner wall surface of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.”

These features are not disclosed in the asserted prior art. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 2 is rejected under 35 USC §102(b) as being anticipated by Yu (U.S. Patent No. 5,779,907).

Claim 2 is rejected under 35 USC §102(b) as being anticipated by Wilks (U.S. Patent No. 5,578,495).

Independent claim 2 has positively recited “magnetic moving means for supporting the magnet so as to be moveable toward and away from the vessel.” This claimed language is supported by way of an example in Figures 4A and 4C, wherein there is indeed a magnetic moving means (4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j) for supporting the magnet 8 so as to be moveable toward and away from the vessel 6. More specifically, in Figure 4A, the magnetic moving means for supporting the magnet 8 so as to be moveable away from the vessel 6, as the magnet 8 is separately below microplate assembly 6. In Figure 4C, magnetic moving means for supporting the magnet 8 so as to be moveable toward the vessel 8, as the magnet 8 is on the same level as microplate assembly 6.

It is well settled that:

“[t]he plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. ... Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson*, 29 USPQ2d 1845, 1848-1850 (Fed. Cir. 1994).

In rejecting the above-enumerated claims, the Office has failed to interpret the claimed language in light of the corresponding structure, material, or acts described therein the specification, and find the same specification or equivalents thereof in the applied prior art of record. Had the Office interpreted the claimed invention in view of *In re Donaldson*, the Office would have readily seen the above-explained feature patentably distinguishes over the claimed invention from the applied prior art of record. Therefore, the Office has not met the requirements of *In re Donaldson*. Consequently, the Office has not met its burden of proving an anticipation rejection. It is respectfully submitted that the Office should not make the next Office action final for the Office has not proven its case. As a matter of fact, the asserted prior art references totally fail to disclose or teach any equivalent of the magnetic moving means for supporting as shown by way of an example in Figure 4A of the present invention. More specifically, equivalent elements of 4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j of the present invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 3 is rejected under 35 USC §102(e) as being anticipated by Schultz et al. (U.S. Patent No. 6,033,911).

To patentably distinguish the claimed invention therefrom, a further feature that a buffer tank 5h is situated between the suction pump 5c and the branch manifold 5b is added. In Schultz, there is no disclosure or teaching of a buffer tank. Naturally, there is also no disclosure or teaching of a buffer tank being situated between the suction pump and the branch manifold. By so amending, independent claim 3 is believed to be patentably distinguished over the Schultz. All claims dependent thereon, by virtue of inherency, are also patentably distinguished over the Schultz.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections under 35 USC §103

Claims 1-4 are rejected under 35 USC §103(a) as being unpatentable over Schultz et al. as applied to claim 3 above, and further in view of Tyberg and Yu.

Regarding claim 1, as clearly shown by way of an example in Figures 5B-5C of the present invention, the distal end 2A of the suction nozzle 2 is in contact with the inner wall surface 6b of the vessel while suction is being performed. Furthermore, the distal end 2A is located at a lowest position of the inner wall surface 6b of the vessel.

To ensure these differentiations are accurately reflected in independent claim 1, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof in contact with a lowest position of the

inner wall surface of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.” These patentably distinguishing features are not disclosed or taught in the asserted prior art references.

Also as clearly seen by way of an example in Figures 5B-5C, the diameter of the suction nozzle 2 is proportionally many times small than the widest portion of the diameter of the vessel 6a. This would permit the distal end 2A to be in contact with the lowest position of the inner wall surface 6b of a vessel 6.

Again, to ensure this distinction is accurately reflected in the claim, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof in contact with a lowest position of the inner wall surface of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.”

These features are not disclosed in the asserted prior art.

Regarding claim 3, a further feature that a buffer tank 5h is situated between the suction pump 5c and the branch manifold 5b is added. In Schultz, there is no disclosure or teaching of a buffer tank. Naturally, there is also no disclosure or teaching of a buffer tank being situated between the suction pump and the branch manifold. These features are not disclosed in the asserted prior art.

Independent claims 3 and 4 have positively recited “magnetic moving means for supporting the magnet so as to be moveable toward and away from the vessel.” This claimed language is supported by way of an example in Figures 4A and 4C, wherein there is indeed a magnetic moving

means (4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j) for supporting the magnet 8 so as to be moveable toward and away from the vessel 6. More specifically, in Figure 4A, the magnetic moving means for supporting the magnet 8 so as to be moveable away from the vessel 6, as the magnet 8 is separately below microplate assembly 6. In Figure 4C, magnetic moving means for supporting the magnet 8 so as to be moveable toward the vessel 8, as the magnet 8 is on the same level as microplate assembly 6.

It is well settled that:

“[t]he plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. … Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson*, 29 USPQ2d 1845, 1848-1850 (Fed. Cir. 1994).

In rejecting the above-enumerated claims, the Office has failed to interpret the claimed language in light of the corresponding structure, material, or acts described therein the specification, and find the same specification or equivalents thereof in the applied prior art of record. Had the Office interpreted the claimed invention in view of *In re Donaldson*, the Office would have readily seen the above-explained feature patentably distinguishes over the claimed invention from the applied prior art of record. Therefore, the Office has not met the requirements of *In re Donaldson*. Consequently, the Office has not met its burden of proving an anticipation rejection. It is respectfully submitted that the Office should not make the next Office action final for the Office has not proven its case. As a matter of fact, the asserted prior art references totally

fail to disclose or teach any equivalent of the magnetic moving means for supporting as shown by way of an example in Figure 4A of the present invention. More specifically, equivalent elements of 4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j of the present invention.

As this is a three way combination rejection including such prior art references, it should be noted that a valid obviousness rejection is not simply combining whatever parts called for in a claim and conclude the combination is obviousness. Otherwise, all claims can be rejected by a parts catalog. Section 2143 of the MPEP has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

Therefore, should the Office either be unable to identify each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply

does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

Prior Art Indicated To Be Pertinent To The Disclosure

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

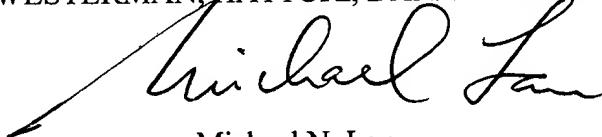
CONCLUSION

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Michael N. Lau
Attorney for Applicant
Reg. No. 39,479

MNL/eg
Atty. Docket No. 010493
Suite 700,
1250 Connecticut Ave., N.W.
Washington, D.C. 20036
(202) 822-1100

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PATENT TRADEMARK OFFICE